REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1-11, 13-20, 22-24, 26 and 27 are pending in this application. In particular, claims 1, 17, 23 and 27 have been amended, claims 12, 21 and 25 have been canceled and claims 2-11, 13-16, 18-20, 22, 24 and 26 have been maintained in their previous form. No new claims have been added. Applicants assert that the amended claims are fully supported by the disclosure of the application as filed, and as such, do not introduce new matter. The status of all the pending claims is reflected in the above listing.

I.   Specification

Paragraph [0001] of the disclosure was objected to by the Examiner for failure to identify related application serial numbers and their current status. Applicants have amended the specification and it is respectfully requested that this objection be withdrawn.

II.   Claims Rejected Under 35 U.S.C. § 103

<u>Claims 1-26</u>

The Examiner has rejected claims 1-26 under 35 U.S.C. § 103(a) as being unpatentable over Dearing et al. (U.S. Publication No. 2002/0183882) in view of Boman et al. (U.S. Publication No. 2004/0100379). These rejections are moot as claims 1, 17 and 23 have been amended.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. <u>In re Royka</u>, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. <u>In re Wilson</u>, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. <u>In re Fine</u>, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP 2143.03.

The Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met because the combination of Dearing and Boman fails to expressly or inherently teach or suggest each and every element of amended independent claims 1,

17 and 23. As described and claimed in the present application, a personality module refers to "a unit with one or more ports for communicating with one or more field devices and with included and/or associated processing power and memory" (pages 17-18, paragraph [0052]). Additionally, the personality module can store information locally, make access decisions, and issue commands to field devices based on the local data stored within the personality module (pages 20-21, paragraph [0059]). Moreover, the personality module is not synonymous with a field device (page 13, paragraph [0043]). The personality module is autonomous and can operate independently without the presence of a server 202. (pages 20-21, paragraph [0059])

Accordingly, the present claims are patentably distinct as written, and the rejection of these claims under Section 103 must be withdrawn. Specifically, claim 1 has been amended to further recite "the personality module capable of operating autonomously from the server." Likewise, claim 17 has been amended to further recite "the at least one modular personality module capable of operating autonomously from the server." Similarly, claim 23 has been amended to further recite "wherein each personality module is capable of operating autonomously from the server."

In contrast, the combination of Dearing and Boman fails to teach or suggest at least one of the claim limitations recited in amended claims 1, 17 and 23, namely, the combination fails to provide a personality module capable of operating independently from a server. The Examiner rejects claims 1-26 on the basis that the modification of the "reader 47" in Dearing with components of the "reader 16" in Boman would provide a personality module as described and claimed in the present application. The Examiner's rejection, however, is apparently built upon the faulty assumption that a Boman reader 16 having a microprocessor 36 and a memory 38 is a personality module rather than a field device. While the Boman reader 16 can exchange and store data between a field device 12 and a server 15, a personality module, as disclosed and claimed in the present application, is distinct and performs different functions from a Boman reader 16. As described above, a personality module is capable of operating autonomously from a server by storing information locally, making the necessary decisions, and issuing commands to field devices independently without the presence of a server. See discussion supra. Unlike a personality module, a Boman reader 16 cannot and does not operate

autonomously from a server.

As described in Boman, the reader 16 "serves primarily as a relay station between the device 12 and the server 15" (pages 3-4, paragraph [0048]). As a relay station, the reader 16 gathers or passes information along from the field device 12 to the server 15, but it does not and cannot operate independently on its own. As illustrated in Boman, to secure a container 10, a security key and an encryption code is generated at a server 15 and transmitted to a device 12 via a reader 16 (page 8, paragraph [0098] and figure 8). Even though the reader 16 incorporates a microprocessor 36 and a memory 38, it does not and cannot independently generate a security key or an encryption code. In another illustration, security check and validation of a container 10 requires comparing responses received within the reader 16 from both the server 15 and the field device 12 (page 8, paragraph [0099] and figure 9). In this instance, the reader 16 functions as an intermediary device by comparing information rather than being an independent autonomous system. Despite having an associated microprocessor 36 and memory 38, a Boman reader 16 performs and functions more as a relay station or as an intermediary field device rather than as a personality module. Accordingly, the Boman reader 16 is not a personality module capable of operating independently from a server as claimed herein.

For the reasons above, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met because the combination of Dearing and Boman fails to teach or suggest a personality module capable of operating independently from a server. In re Royka. Since amended independent claims 1, 17 and 23 are not obvious under Section 103, then any claim depending therefrom is nonobvious, namely claims 2-11, 13-16, 18-20, 22, 24 and 26. In re Fine. Therefore, the rejection of these claims should also be withdrawn.

III.   Claims Rejected Under 35 U.S.C. § 102

Claim 27

Claim 27 was rejected under U.S.C. § 102(e) as being anticipated by Boman. This rejection is moot as claim 27 has been amended.

"Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann

<u>Maschinenfabrik GmbH v. American Hoist & Derrick Co.</u>, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing <u>Connell v. Sears, Roebuck & Co.</u>, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Boman fails to expressly or inherently disclose at least one element recited in amended independent claim 27.

Accordingly, the present claim is patentably distinct as written and the rejection of this claim under Section 102 must be withdrawn. Specifically, claim 27 has been amended to further recite "the personality module capable of operating autonomously from the server." The arguments made above with respect to the basis and support in the specification for amending claim 27 apply with equal force here. See discussion <u>supra</u>.

Boman, in contrast, fails to disclose or teach all of the elements recited in amended independent claim 27, namely, Boman fails to disclose a personality module capable of operating independently from a server. See discussion <u>supra</u>. The arguments made above with respect to amended independent claims 1, 17 and 23 regarding the applicability of the Boman reference apply with equal force here. See discussion <u>supra</u>. Thus, Applicants respectfully assert that amended claim 27 is patentably distinct as written and the rejection of this claim under Section 102 should accordingly be withdrawn.
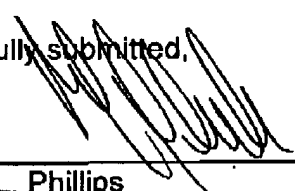
IV.   Conclusion

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

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